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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/674,930

09/30/2003

Terry L. Schneider

7784-000553CPB

5157

27572

7590

05/05/2005

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EXAMINER

DIXON, MERRICK L

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/674,930

Applicant(s)

SCHNEIDER

Examiner

Merrick Dixon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9303 & 2-9-04.

MERRICK DIXON

PRIMARY EXAMINER

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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The abstract of the disclosure is objected to because it includes the legal word, 'comprises'. Correction is required. See MPEP § 608.01(b).

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The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 1-4,6,7,10,11,14,15,16,18,19,20,22,23,24,25 , 26 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5,6,8,11,12,13 of copending Application No. 10/675557.

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Although the conflicting claims are not identical, they are not patentably distinct from each other because they both are essentially claiming the same compound except naming the differently .

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paine et al (US 5614305) in view of Chiou et al(US 5369163).

The cited primary reference teaches the basic claimed invention including a composition comprising a base material with a plurality of SMA particles therein – col 3, lines 43- col 4, line 14; col 4, lines 14; col 13, lines 6-18, col 15, claim 1. The reference fails to teach the aspect that such composition could be used as paint or protective coating. The secondary reference to Chiou et al teaches this aspect in col 7, lines 41-51 ;col 9, lines 22-25. It would have been obvious to one of ordinary skill in the art at the time the invention is made to combine the teachings of the secondary reference to Chiou et al and utilize the resulting matrix taught by the primary reference to produce enhanced paints- see col 9, line 25. Concerning claims 2,13,15,25 and 34, the secondary reference

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teaches similar claimed particle dimensions in col 1, lines 15-20. Concerning claims 3 and 16, the primary reference teaches nitinol particles in col 3, lines 43-44. Concerning claims 4,18,30,31 and 32 , the secondary reference teaches various shapes for its particles including spherical ones – see .col 8, lines 22-59; col 26, Example 173. It is submitted such shapes could also include ovals and cylindrical, in the absence of unexpected results and if not taught. Concerning claims 5,17,8,21 and 35, the primary reference teaches that the particles could be both randomly and/or evenly distributed throughout the material- col 4, lines 45-52. Concerning claims 6,7,19,20,28 and 29,the primary reference teaches similarly claimed percentages throughout the disclosure- see col 5, lines 43-51; claim 13. Concerning claims 9 and 36, the secondary reference teaches paint material in col 7, line 42;; col 9, line 25. Concerning claims 10 ,11 23 and 22, the primary reference teaches martensitic phrase for the particles- claim 1. In regards to claims 11 and 23, Paine et al, teaches its SMA particles to undergo transformations in col 1, line 63. It is notoriously well known , in the art, that SMA transforms between its martensitic and austenitic phrases when external forces is accordingly applied thereto. It is submitted that such transformations would indeed occur between the phrases of the reference's SMA, in the absence of unexpected results. Concerning claims 2,12,24,27 and 33, the the primary reference teaches similar sizes in col 8, lines 14-27; col 9, line 19- col 10, line 7. The secondary reference also teaches the sizes to be less than 400 mm in col 8, lines 33.

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Applicants who wish to send a facsimile (draft copies) for the examiner,s immediate review can do so by using the Examiner,s personal fax number at 571-273-1520. The faxing of all papers must conform with the notice published in the Official Gazette, 1096 O.G. 30 (November 15, 1989). **NOTE: All facsimiles sent to the examiner's personal fax number should be in draft-forms and will be treated as informal.**

Same facsimiles will not be entered in the related applications unless otherwise agreed and noted by the examiner.

The fax number for all other fascimile is 703-872-9306.

Information about **the status of an application** may be obtained from the Patent Information Retrieval system (**Private PAIR**).

Status inquires for **published applications** may be retrieved from either **Private PAIR** or **Public PAIR**. Questions about the PAIR system should be directed to the Electronic Business Center at **866-217-9197**.

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Any questions concerning the instant communication should be directed to Examiner Dixon, at 571-272-1520, Mondays to Thursdays, between 12 noon and 8 PM, eastern time . The examine's supervisor, Mrs. Rena Dye, can be reached at 571-272-3186.

A handwritten signature in black ink, appearing to read 'Merrick Dixon', with a stylized, cursive script.

Merrick Dixon

Primary Examiner

Group 1700